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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,941	02/18/2000	Masahiro Odaira	35.C14264	9142
5514	7590	01/20/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HA, YVONNE QUY M	
		ART UNIT	PAPER NUMBER	
		2664	DATE MAILED: 01/20/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/506,941	ODAIRA, MASAHIRO
	Examiner Yvonne Q. Ha	Art Unit 2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Response to Amendment***

1. Claims 1-12 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5, 7, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Azami (US Patent 5,889,842).

Referring to claims 1, 5, and 9, Azami discloses a communication apparatus connected to an ISDN which comprises (abstract): decision means for, when call connection fails, deciding a reason for the failure in connection (col. 5, lines 5-18); setting means for setting a timer value used to wait for a predetermined time (col. 7, lines 8-29, a waiting state with a timer for a start and agreement tones before switching modes; figure 5) when the decision means (col. 5, lines 5-14, i.e. detecting) decides a mismatch in communication mode (col. 5, lines 5-10, mismatch; figure 4); and control means adapted for waiting for the predetermined time in response to the decision of a mismatch in communication mode made by the decision means (col. 7, lines 8-29, a waiting state with a timer for a start and agreement tones before switching modes), and then switching the communication mode to another communication mode to try the call connection again (col. 5, lines 19-32; col. 7 lines 24-41).

Referring to claims 3, 7, and 11, Azami discloses a communication apparatus connected to an ISDN (col. 1, lines 8-15), having a plurality of communication protocols in a B channel (col. 1, lines 13-15, different modes implies different rates where ch. B is transparent mode-TBCS at 64kb/s using G4 stack protocol, and ch. D is non-transparent mode-NTBCS at 16kb/sec for call control), said apparatus including D-channel control means for controlling a call in a D channel (col. 4, lines 18-30, ch. D is non-transparent mode-NTBCS at 16kb/sec for call control), and a plurality of B-channel control means for conducting protective controls corresponding to a plurality of communication modes in the B channel (col. 6, lines 55-58, two B channels), said apparatus comprising: decision means for, when call connection by the D-channel control means fails, deciding whether or not call connection should be tried by the D-channel control means again after switching a communication mode in the B channel to another communication mode (col. 6, lines 55-62, two B channels can be simultaneously connected in either mode 1 or 2); timer control means for waiting for a predetermined time when the decision means decides that the call connection should be tried by the D-channel control means again after the switching to such another communication mode in the B channel (col. 10, lines 33-44, retries a call for a different mode in ch.B); and control means adapted for switching to said another communication mode in the B channel after waiting for a predetermined time by the timer control means to try the call connection again by the D-channel control means (col. 10, lines 44-49, communication mode is changed for a short time).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 6, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azami (US Patent 5,889,842) in view of Otani (US Patent 5,367,522).

Referring to claims 2, 4, 6, 8, 10, and 12, Azami discloses all aspects of the claimed invention but failed to teach the decision of call retry without switching the communication mode. However, Otani discloses when the first setting of an additional connection has failed, call retry of the setting can be automatically initiated after a predetermined period of time (col. 21, lines 26-33, figure 16). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to initiate a call retry without switching the communication mode. One of ordinary skill in the art would have been motivated to apply a call retry since it is not necessary to perform a mode change when the destination end is busy. During the call busy state one does not know whether it is in the right mode or not until communication between the two end points begin. Therefore, it would waste of processing if applying mode change.

Response to Arguments

6. In response to applicant's argument on amendment page 3, lines 15-16, the examiner respectfully disagrees because Azami teaches different waiting states with the timer (figure 5) for different types of tones such as start, agreement, setting and completion tones. In addition, it is noted that the features upon which applicant relies (i.e. the predetermined time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Charbonnier (US Patent 5,471,317) discloses videotext facsimile machine
- Bentley et al. (US Patent 5,537,404) discloses switched circuit connection management over public data networks for wide area networks
- Hughes-Hartogs (US Patent 5,854,829) discloses ISDN fax routing

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne Q. Ha whose telephone number is 703-305-8392. The examiner can normally be reached on Monday-Friday 7a.m.-4p.m. Eastern.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

YQH



WELLINGTON CHIN
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